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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,787	07/31/2001	Jeffry J. Grainger	020313-000520US	4834
20350	7590	06/08/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 06/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/919,787		GRAINGER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Janice A. Mooneyham		3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. This is in response to the applicant's communication filed on March 26, 2006, wherein:

Claims 1-20 are currently pending;

Claims 14-20 are newly added;

Claims 1-4 have been amended.

***Response to Amendment***

***Claim Rejections - 35 USC § 101***

The rejection under 35 U.S.C. 101 has been withdrawn.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how displaying the second case comprises displaying a third case.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim language is *allowing* a user to select at least one electronic document. Using terms like "allowing" or "permitting" an action, e.g. "allowing a user to search a database", the steps are distinct from actually doing the action, e.g. searching.

Applicant has also failed to identify what applicant means by the term "relevant" document. The Examiner has interpreted this as relevant prior art.

The Examiner is unclear as to what the applicant is trying to claim as applicant's invention. The applicant identifies the invention as a computer implemented method of managing information disclosure statements. However, the claim language appears to be directed to document management or grouping and analysis method.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Rivette et al (US 2003/0046307) (hereinafter referred to as Rivette).

Referring to Claims 1-9 and 19-20:

Rivette discloses a system, program and computer implemented method of managing electronic documents comprising:

a processor (Figure 11 (1106), paragraph [0285]) and computer readable medium in communication with the processor comprising a set of instructions executable by the processor for performing the method of [0289-0290];

providing a user with access to a plurality of electronic documents (Figure 3 (316), [0277] [0304], [0311]);

associating a first set of electronic documents, comprising one or more of a plurality of electronic documents, with a first case, wherein the first case corresponds to a patent application, and wherein associating the first set of electronic documents with the first case comprises identifying the first set of electronic documents as relevant to the first patent application (Figure 2, [0020], [0023-0024][0278];

associating a second set of electronic documents, comprising one or more of a plurality of electronic documents, with a second case corresponding to a second patent application, and wherein the associating comprises identifying the second set of electronic documents as relevant to the second patent application (Figure 2, [0264]);

allowing the user to select at least one electronic document in the second set [0292], [0354-0355] [1193]); and

associating the selected document to the first case, wherein the first and second case are related cases, or have a common inventor, or same assignee, or relate to a continuation or CIP ([0261-0262] [0349-0357], [0366], [0373-0379] [1157-1159], [0133], Figure 100).

Referring to Claim 2:

Rivette discloses displaying the second case and links to the second set for the user (Figure 145A [0125-0126] [1222]).

Referring to Claim 3:

Rivette discloses wherein displaying the second case further comprises displaying a third case and links to a third set of documents, the third case corresponding to a third patent application (Figure 145A, [0125-0126], [1225-1228]).

Referring to Claim 4:

Rivette discloses displaying document references for the electronic documents in the first and second sets in individual rows of a first column, and displaying first and second case identifiers at the top of second and third columns, wherein the rows of second column include a marker when the electronic document corresponding to the row is associated with the first case and wherein the rows of the third column include a marker when the electronic document corresponding to the row is associated with the second case (The Examiner is unclear what the applicant is trying to claim with this language, but applies prior art as best as the Examiner understands the claim language)(Figure 6 [0303-0309], Figures 13-17, Figures 33-38).

Referring to Claim 10:

Rivette discloses displaying a search screen to search for additional cases (Figure 53) [0388-0417 Searching Module]).

Referring to Claims 11-13:

Rivette discloses wherein the electronic documents is an electronic version of a US Patent or a foreign patent document, or a publication [0376].

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Referring to Claim 14:

Rivette discloses storing at least some of the plurality of electronic documents in a database or storing information from at least some of the plurality of electronic documents [0373-0379], [0453] [1157-1159],[1193].

Referring to Claim 15:

Rivette discloses allowing the user to search the web [0484-0485] [1209-1212].

Referring to Claim 16:

Rivette discloses allowing the user to search a database, wherein the database is maintained by an official patent office [0321].

### ***Response to Arguments***

4. Applicant's arguments with respect to claim 1-20 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

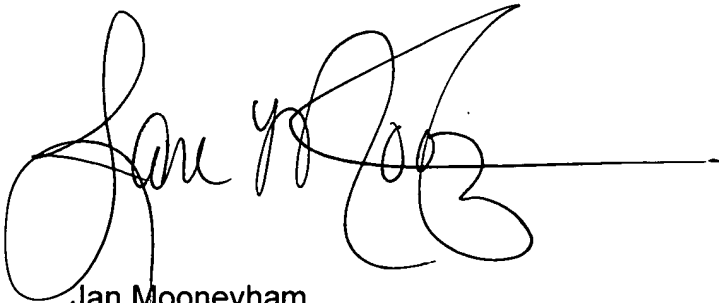


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', followed by a horizontal line.

Jan Mooneyham  
Patent Examiner  
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